

## **REMARKS**

The Examiner's study of this application is respectfully appreciated.

The amendment to the specification is merely done to make the sentence clearer and does not raise any new matter. Entry of the amended paragraph is appropriate and respectfully requested.

### **Section 101 Double Patenting Rejection**

The most recent office action first rejects claims 19-25 as defining the same invention double patenting under §101 of the Patent Act relative to claims 1-7 of applicant's own Patent No. 6,668,880. This rejection is inappropriate since all of claims 19-25 have different claim language and substantial differences in the scope of the claims. This makes a §101 double patenting rejection inappropriate. Before explaining the differences in the claims it may be helpful to consider the guidance provided by the applicable MPEP section.

MPEP §804 addresses double patenting. At part II. A. thereof is specific explanation concerning statutory §101 double patenting. The test stated therein is:

Is the same invention being claimed twice? . . . . "Same invention" means identical subject matter.

The next paragraph states:

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent.

The proper legal test of identicalness under §101 is not met where there are meaningful differences between the claims. The §101 rejection made applied to

claims 19-25 of this application as being the same claims as claims 1-7 of the applicant's prior Pat. No. 6,668,880.

Now there will be listed a number of differences that make this rejection clearly inapplicable.

A. Claim 1 of the Patent recites a self-propelled vehicle whereas claim 19 is not limited to a self-propelled vehicle. Nor are there limitations to "powering the self-propelled vehicle overland;". Claim 19 includes a non-self-propelled vehicle whereas claim 1 of the Patent is limited to self-propelled vehicles.

B. Claim 1 of the Patent recites:

"an operational head mounted near the distal end of said at least one boom; said head being capable of swivel action from side-to-side and tilting action front-to-back to facilitate following contours of land being cleared;"

Whereas the apparent corresponding language of claim 19 of the application now reads:

"an operational head mounted to said rotary hydraulic actuator for pivotal movement about both said first and second pivot axes;"

The underlined language of claim 1 of the Patent is simply not included in claim 19 of the application. The meaning and scope of the compared language proves there is no double patenting under §101. Adjustable orientation does not necessarily mean the same as the underlined passage which recites side-to-side and front-to-back tilting action. Thus this part of claim 19 does not claim the same thing. It further is rendered not the same

and non-obvious because claim 19 recites the adjustable orientation is about two generally transverse pivot axes.

The above limitations clearly show that claim 19 is not the same subject matter as claim 1 of the Patent pursuant to §101.

Claims 2-5 of the Patent are dependent upon claim 1 and thus all the differences of corresponding claims 20-23 are also different for the same reasons. Claim 5 is additionally different in reciting that the turret rotates, whereas claim 23 recites the turret pivots. Rotates does not necessarily mean the same thing as pivots.

The second main claim of the Patent is claim 6. Corresponding claim 24 does not recite the same subject matter. Claim 24 does not recite a self-propelled vehicle whereas claim 6 of the Patent differs in that it recites a self-propelled vehicle having ground engaging tracks. This is clearly different language with a different scope of exclusive patent coverage.

Claim 24 also recites a turret mounted upon the vehicle for pivotal movement thereon. Whereas, claim 6 recites the turret is mounted upon the self-propelled vehicle for rotation thereon. Pivoting does not necessarily mean rotation. Thus, claim 6 of the Patent versus claim 24 of this application are not claiming the same invention.

Claim 6 of the Patent also recites that the operational head is capable of swivel action from side-to-side and tilting action front-to-back. Corresponding claim 24 does not so recite but instead recites that there is an articulation mechanism to provide adjustable orientation. This is a difference in scope. It also recites that the adjustable orientation is about two generally transverse pivot axes. Swivel action from side-to-side and tilting

action front-to-back are not identical to adjustable orientation about two generally transverse pivot axes.

Claim 24 is further different from claim 6 of the Patent because it does not include the last paragraph of claim 6 directed to a hydraulic fluid cooler mounted to cool hydraulic fluid used to power the comminuting motor.

Claim 25 of the application adds limitations to claim 24 for a hydraulic fluid cooler. Although claim 25 is closer to claim 6 than claim 24, the other distinctions still apply and claim 25 does not claim the same subject matter as claim 7 of the Patent.

In view of the differences between claims 19-25 versus claims 1-7 of the Patent, the §101 double patenting rejection does not meet the judicially determined test for claiming the identical invention. Positive withdrawal of this rejection is requested in the next office action.

### **Prior Art Rejection**

All claims were rejected under §102(b) as anticipated by Emery. A first and principal distinction is that the invention of Emery cuts or saws limbs off of the sides of trees so the trunk can be quickly felled and recovered without limbs. It says nothing in my reading that indicates the cutting disk of Emery performs a comminuting function which allows the trees or brush to be disintegrated so no disposal or hauling is needed from the site. This is of particular advantage in clearance of right-of-ways because the objective is to eliminate the trees and brush under power lines at a minimum cost and without leaving acres of limbs and debris.

The construction of the sawing disk of Emery is shown and described as having teeth along the perimeter or bottom to cut the limbs or brush. This must be compared to applicant's invention which can totally grind up a conifer tree about 40 feet high and 8 inches in diameter near the base of the tree, in less than 10 seconds, leaving wood chips and other small wood debris which can decompose and help prevent soil erosion. Thus, ***the applicant's invention performs a recited functional capability not taught by the Emery patent and Emery does not inherently possess such capability.***

Claim 19 is further non-obvious and patentable over the Emery patent because it recites an actuator mount connected to the distal end of the at least one boom which may articulate about said first pivot axis; a rotary hydraulic actuator connected to said actuator mount which pivots about a second pivot axis which is generally transverse to said first pivot axis; and an operational head mounted to said rotary hydraulic actuator for pivotal movement about both said first and second pivot axes. These features in the recited combination of features of claim 19 define non-obvious and patentable subject matter over the reference to Emery.

Emery has only a single pivotal axis at the distal end of the boom. This does not provide the ability to move with two degrees of freedom and have a complex field surface or tree surface over which the operation head can move with comminuting devices driven by a comminuting motor having power from a secondary engine which substantially dedicates engine power to the comminuting motor. Claim 19 is believed to define non-obvious and patentable subject matter. Section 103 requires that a patent be granted unless it is obvious to one of ordinary skill in the relevant art. Allowance is appropriate and respectfully requested.

Claims 20-23 and 36-41 are dependent from claim 19. Hence, they are allowable for all the reasons given above with respect to claim 19. Each claim adds further features or limitations which additionally render the claimed inventions non-obvious to one of ordinary skill in this art.

Claim 24 is a second independent claim. It defines an implement for clearing land by comminuting and grinding brush and trees at an operational site in the field to clear the land by leaving the comminuted brush and trees at the operational site. This recited function is not shown nor suggested by Emery.

Claim 24 is also allowable because it recites an articulation mechanism mounted near the distal end of the boom to provide adjustable orientation about two generally transverse pivot axes. Emery does not show such a feature and does not teach or suggest the combination of features recited in claim 24.

Claims 25-35 are dependent from claim 24 and are allowable for the reasons explained above, along with added limitations particular to each dependent claims. Claim 31 recites that the at least one comminuting device has a plurality of grinding elements thereon which extend along both sides of a comminuting disk. Claim 32 further recites a jaw mounted for pivotal action at a back side of said operational head. Claim 33 is additionally allowable in that it recites a jaw mounted for pivotal action at a back side. Claim 34 recites that the jaw has serrations thereon along both sides. Claim 34 is additionally non-obvious in that the pivotal jaw is recited to have serrations on along both sides thereof. Claim 35 is additionally allowable because it recites comminuting devices mounted upon an upper face, lower face and periphery of at least one rotating member.

Claims 36-41 are dependent from claim 19 and allowable therewith. Added limitations are recited in dependent claims 36-41 which have similar arguments as given above.

It is believed that all claims presented in this application are allowable subject matter over Emery and other references of record.

Proper interpretation and application of the language of §103 and the recited inventions of the claims having combinations of recited features and added capabilities properly indicates that the inventions are non-obvious to one of ordinary skill in the related art.

Allowance of this application is believed appropriate and respectfully requested.

Respectfully submitted,

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By:

Randy A. Gregory  
Randy A. Gregory  
Reg. No. 30,386